

Response to Office Action
S/N 10/772973

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REMARKS

DEC 20 2006

A. Status of Claims

Claims 4, 10, 14-29, 31, and 32 are pending. Claims 20-29, 31, and 32 are cancelled herein.

B. Amendment to Specification

Paragraph [0002] has been amended to properly reference the related applications, now that the parent application has issued as a patent. No new benefit is claimed.

C. Joint Inventors

The Examiner states that he presumes that "the subject matter of the various claims was commonly owned at the time any inventions covered therein were made, absent evidence to the contrary." It is unclear as to which prior art, if any, the Examiner is considering under 35 USC §103(a) and (c) that causes him to caution Applicants of the obligation to disclose ownership of claims not commonly owned vis-à-vis prior art. However, Applicants affirmatively state that the subject matter and all claims of *this* application were commonly owned or under a legal obligation to be assigned to the same business entity at the time the invention was made.

D. §102(e) Rejection

The Examiner has rejected claims 4, 10 and 14-19 under 35 USC 102(e) as being anticipated by Yayama and Gerdes. However, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2nd 1051 at 1053 (Fed. Cir. 1987) (emphasis added). The Examiner has combined references to make an anticipation rejection. This is simply improper under patent law and Applicants request that the rejection be withdrawn.

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Further, the Examiner admits that Yayama does not teach different spot shapes. See page 3 of the November 1, 2006 office action, second paragraph. Claims 4, 10 and 14-19 claim a spot shape. Therefore, Yayama alone cannot anticipate claims 4, 10 and 14-19 because Yayama does not inherently or expressly disclose an element of those claims. Gerdes does not disclose a number of claimed limitations, including a plurality of sources in a hand-held wand, two beams of different colors, two beams emitted simultaneously from the same wand, an optical arrangement, or a linear spot shape. Therefore, Gerdes alone cannot anticipate 4, 10 and 14-19 because Gerdes fails to disclose a host of claimed limitations. Applicants again request that the rejection be withdrawn.

D. §103(a) Rejection

The Examiner has rejected claims 20-29, 31, and 32 under 35 USC 103(a) as being obvious in light of Yayama, Gerdes, and Tatebayashi. Applicants have cancelled claims 20-29, 31, and 32 herein, and therefore this rejection is moot.

CONCLUSION

Applicants respectfully submit that all objections and rejections have been traversed, and that the application is in form for issuance. Applicants respectfully request that the Examiner allow the application to proceed to issuance.

Respectfully submitted,



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